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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,347	04/25/2001	Tohru Takahashi	950376D1/HG	7829

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
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NEW YORK, NY 10017-2023

EXAMINER

FRONDA, CHRISTIAN L

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/15/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/842,347

Applicant(s)

TAKAHASHI ET AL.

Examiner

Christian L Fronda

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48,55,60,61,63,71-75,77-80,89 and 90 is/are pending in the application.
- 4a) Of the above claim(s) 61,63,71-75,77-79,89 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48,55,60 and 80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/500,635.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1652

## DETAILED ACTION

### *Election/Restriction*

1. Applicants' election of Group I, claims 48, 55, 60, and 80, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Affirmation of this election must be made by applicant in replying to this Office action. Claims 61, 63, 71-75, 77-79, 89, and 90 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
2. Claims 48, 55, 60, and 80 are under consideration in this Office Action.

### *Claim Rejections - 35 U.S.C. § 112, 1st Paragraph*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 48, 55, 60, and 80 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.  
The claims are directed to all possible polypeptides "consisting essentially" of amino acid residues 4-437 of SEQ ID NO: 2, all possible polypeptides "consisting essentially" of amino acid residues 1-526 of SEQ ID NO: 12, or all possible polypeptides "consisting essentially" of amino acid residues -23-526 of SEQ ID NO: 12. The specification, however, only provides a single representative species encompassed by these claims: a polypeptide comprising the amino acid sequence of SEQ ID NO: 2 or SEQ ID NO: 12. There is no disclosure of any particular structure to function/activity relationship in the single disclosed species. The specification also fails to describe additional representative species of these polypeptides by any identifying structural characteristics or properties for which no predictability of structure is apparent. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to

Art Unit: 1652

sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

### ***Claim Rejections - 35 U.S.C. § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 48 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Dougherty et al. (Accession AAR40841) or Boy et al. (Accession S18921).

Dougherty et al. (Accession AAR40841) teach a polypeptide having an amino acid sequence "consisting essentially" of amino acid residues 4-437 of SEQ ID NO: 2 (see attached alignment). Thus, the reference teachings anticipate the claimed invention.

Boy et al. (Accession S18921) teach a polypeptide having an amino acid sequence "consisting essentially" of amino acid residues 4-437 of SEQ ID NO: 2 (see attached alignment). Thus, the reference teachings anticipate the claimed invention.

7. Claims 55 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Creissent et al. (Accession S38908).

Creissent et al. (Accession S38908) teach a glutathione reductase having an amino acid sequence "consisting essentially" of amino acid residues 1-526 or -23 to 526 of SEQ ID NO: 12 (see attached alignment). Thus, the reference teachings anticipate the claimed invention.

### ***Conclusion***

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. The Examiner can be contacted Monday-Friday from 8:30AM - 5:00PM. If attempts to reach the

Art Unit: 1652

examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF

A handwritten signature in black ink, appearing to read 'Ach', is positioned above the printed name and title.

PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600